

REMARKS

The Office Action mailed September 1, 2010, has been received and carefully considered. Claims 1 and 7 have been amended, and claim 5 has been cancelled. To the best of the undersigned attorney's information and belief, these changes contain no new matter for the reasons given in the remarks which follow.

A Declaration under 37 C.F.R. §1.132 is submitted herewith in support of Applicants' arguments. The comparative tests presented in the Declaration illustrate the unexpectedly good results obtained for Applicants' claimed "buffer particles having a average particle diameter, D_1 , ranging from 100 μ m to 200 μ m" compared to the particle size range of the closest prior art, Aoki et al. Applicants' claims are believed to be commensurate in scope and the significance of the test results is discussed in the Declaration.

Claims 1, 2, 4, and 7 are active in the Application and are submitted to be in allowable condition. Claim 1 is independent.

Claims 8 and 9 have been withdrawn as non-elected in responding to a restriction requirement. When the Examiner finds the elected claims allowable, Applicants request that claims 8 and 9 be rejoined and examined in this Application since the speed reduction gear of claim 8 includes the composition of claim 1 and the electric power steering apparatus of claim 9 includes the speed reduction gear of claim 8.

Claim Changes and Support

Independent claim 1 has been amended to recite, "(a) buffer particles having an average particle diameter, D_1 , ranging from 100 μ m to 200 μ m and made of a rubber or a soft resin selected from the group consisting of polyolefin resin, polyamide resin, polyester resin, polyurethane resin, polyacetal resin, polyphenylene oxide resin, polyimide resin, fluororesin and thermosetting urethane resin, ...".

These changes find support in the Specification in paragraphs [0025] and [0027] which present Applicants' preferred materials and preferred D₁ range.

Claim 7 has been amended to close the parenthesis at the end of the claim that was inadvertently previously deleted.

The continuing rejection of claims 1, 2, 4, and 7 under 35 U.S.C. §103(a) as unpatentably obvious over Nakatani et al. (US 2003/0176298) in view of Aoki et al. (US 5,354,487) is respectfully traversed.

A. The Examiner acknowledges that the lubricant composition of Nakatani et al. does not comprise fine particles (see the Office Action, page 3, section 7, the last sentence). The Examiner therefore relies on Aoki et al. as teaching solid lubricant additives for use in bearings and in gear oils, bearing oils, and greases (Col. 1, lines 46-52). The Examiner considers the solid lubricant additives to be cured products having particle sizes of less than 100mm and are thus "fine particles" meeting the limitations of claims 1, 4, and 5.

B. Further, the Examiner has taken the position (1) that Nakatani et al. and Aoki et al. teach lubricant compositions comprising butadiene particles which serve as buffer particles in the grease and are present in amounts of 0.01 to 50 parts by weight which overlaps the range in Applicants' claims, and (2) that, since similar lubricant and additives are taught, the mixing consistency of the grease would be similar to that in our claims, i.e., inherently.

C. Applicants respectfully disagree that the combined disclosures of Nakatani et al. and Aoki et al. render obvious amended independent claim1, or dependent claims 2, 4, and 7 for analogous reasons, which reasons follow.

D. In particular, independent lubricant composition claim 1 has been amended to recite the invention with greater particularity and now includes limitations regarding Applicants' preferred average particle diameter, D₁, being from 100µm to 200µm, and Applicants' preferred soft resin selected from the group consisting of polyolefin resin, polyamide resin, polyester

resin, polyurethane resin, polyacetal resin, polyphenylene oxide resin, polyimide resin, fluororesin and thermosetting urethane resin, which are neither taught nor suggested in either the disclosure of Nakatani et al. or Aoki et al., taken alone or in combination.

E. Moreover, a Declaration under 37 C.F.R. 1.132 is submitted herewith in support of patentability of the amended claims. The comparative test results presented are believed to rebut any *prima facie* case of obviousness that may be deemed to exist.

F. In view of the foregoing distinctions, Applicants respectfully submit that the combined disclosures of Nakatani et al. and Aoki et al. do not meet Applicants' independent Claim 1 as amended so that no *prima facie* case of obviousness is made out now against independent Claim 1, or dependent claims 2, 4, and 7, and withdrawn claims 8 and 9, for analogous reasons. In the alternative, the comparative test results presented in the Declaration submitted with this response are believed to rebut any *prima facie* case of obviousness that may be deemed to exist. In view of these points, Applicants believe that this ground of rejection should be withdrawn.

CONCLUSION

In view of the foregoing amendments and remarks, Applicants submit that claims 1, 2, 4, and 7 are in condition for allowance. Applicants therefore request that claims 8 and 9 be rejoined and examined in this Application since Applicants consider that claims 1, 2, 4, and 7-9 and the Application are in condition for allowance. Reconsideration and passage of this case to issue are therefore requested.

Should the Examiner consider that a conference would help to expedite the prosecution of this Application, the Examiner is invited to contact the undersigned to arrange for such an interview.

Request for Extension of Time

Applicants request a first extension of time for responding to the Office Action dated September 1, 2010. A first extension fee of \$130.00 is now due. This fee is submitted herewith in the attached credit card form PTO-2038. Should the remittance be accidentally missing or insufficient, the Commissioner is hereby authorized to charge the fee to our Deposit Account No. 18-0002, and is requested to advise us accordingly.

Respectfully submitted,



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Date

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